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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/978,383      | 10/16/2001  | John E. Sherry       | 498-261             | 4258             |

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06/03/2003

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EXAMINER

JACKSON, SUZETTE JAMIE

ART UNIT

PAPER NUMBER

3738

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>09/978,383 | Applicant(s)<br>SHERRY, JOHN E. |  |
|                              | Examiner<br>Jackson J Suzette | Art Unit<br>3738                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16, 18-25, 28-30 and 32-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38 and 39 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-12, 14-16, 18-25, 28-30 and 32-37 is/are rejected.
- 7) ☒ Claim(s) 6 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

1. Applicant's amendment dated 03/24/03 has been received in application serial number 09/978,383.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 7-12, 14-16, 18-25, 29-34, 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. 6,319,276. Holman et al. discloses the invention as claimed noting figures 1-12 comprising: a tubular member (10) and an outer covering (22, 24, 50), sealed to portions of the tubular member, a pocket being defined between the tubular member and an outer covering to accommodate a pre-determined agent *in forming a seal ring*, wherein the outer covering being impervious to said pre-determined agent *wherein the pocket singularly circumscribes the tubular member in an annular shape*. See col. 1, lines 41-65, col. 2, lines 3-24, co. 3, lines 1-3, col. 3, lines 44-47, col. 4, lines 18-26, col. 4 lines 30-34, can col. 4, lines 53-54. It is obvious ~~is~~ not inherent that the curing agent of Holman et al. (see col. 3, lines 46-67) forms a sealing ring as it hardens between member (10) and (14, 16). It is also obvious that the peripheral circular conduits or tubes (col. 3, lines 9-10) singularly surround the tubular member. See figure 2, 6 and 7 of the current application vs. figures 2-5 of Holman et al.

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4. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. in view of 5,151,105 in view of Kwan-gett. Holman et al. has been disclosed above however Holman et al. does not specify the use of an expandable stent. Kwan-Gett teaches the use of a tubular sleeve graft in conjunction with a stent. See figure7. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the stent with graft as in the Kwan-Gett patent with the graft of the Holman et al. Patent because it is well know in the art that expandable stents have been utilized for supports the graft structures.

5. Claims 28 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman et al. in view of McDermott et al. 6,312,462. Holman has been disclosed above however Holman does not specify that the curing agent is urethane. McDermott et al. teaches expanding a bifurcated graft device with inflation fluids such as urethanes (see col. 4, line 32). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize urethane because it also would cause the graft of Holman to expand and form the pocket.

*Allowable Subject Matter*

6. Claims 38-39 are allowed.

7. Claims 6 and 13 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

*Response to Arguments*

8. Applicant's amendment and arguments filed 3/24/03 have been fully considered but they are not persuasive. Applicant amends the claims and argues a compliant seal ring that is not constrained by remaining portions and singularly circumscribes the tubular member in an annular shape of the prosthesis (see page 6 of response), however the seal ring is connected by channel (22 in figures 2, 6-7 etc.) and thus equates to Holman et al. (see figures 2-5).

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzette J. Jackson whose work schedule is Monday-Friday 9-6:30 off every other Friday and whose telephone number is 703-308-6516.

11. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3580.

12. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Suzette J. Jackson  
27 May 27, 2003

  
David H. Willse  
Primary Examiner